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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/879,302

08/06/2001

Nozomu Ikeda

6158

530

7590

06/23/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,302

Applicant(s)

IKEDA ET AL.

Examiner

Paul Callahan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76, 129 and 130 is/are allowed.
- 6) ☐ Claim(s) 77-128 and 131-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09131095.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-75 were filed with the instant application and have been cancelled in favor of new claims 76-145, as per the preliminary amendment filed 6/12/01. Claims 76-145 are pending and have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/131,095, filed on 8/7/98.

Drawings

3. The replacement for missing drawing figure 9 was received on 8/6/01. These drawings are approved.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 93 is rejected under 35 U.S.C. 101 because the claim is directed to both an apparatus, and a method step for using the apparatus. Such a combination of

statutory classes of invention is in itself non-statutory. See MPEP Sec. 2173.05:

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 116 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 116 recites the limitations: "An information signal reproducing method for reproducing information signals to which device-related information related to a recording method has been added", and "obtaining device-related information related to the reproducing method for use in reproducing the information signals." Neither of these features are described in the specification.

Claims 117-123 are dependent on claim 116 and are thereby rejected on the same basis as is that claim.

Claim 132 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 132 recites the limitations: "obtaining output-side device-related information related to the output device" and "adding the device-related information obtained by the output-side device-related obtaining step to the information signals" The specification does not describe a step of adding such output device-related information to an information signal.

Claims 133, 134, and 136-140 are dependent on claim 132 and are thereby rejected on the same basis as is that claim.

Claim 141 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 141 recites the limitations: "obtaining

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output-side device-related information related to the output device” and “converting additional information on the basis of the device-related information from th[sic] output-side device-related information obtaining step” and “adding the additional information converted by the additional converting step to the information signals” The specification does not describe a step of adding this information to an information signal.

Claims 142-145 are dependent on claim 141 and are thereby rejected on the same basis as is that claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 77, 78, 79, 80-87, 93-100, 125, 132-140, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for claim 77, lines 21-24 of the claim contain the passage: “control means for prohibiting the reproduction of the information from the reproducing side medium-related information reading means is not consistent with the medium-related information detected by the detecting means..” The meaning of the passage is not clear.

As for claim 79, the claim recites the limitation: "means for providing second code for providing code identical with said first code." The meaning of the passage is not clear.

As for claim 78, it recites the limitation "means for detecting the device-related information superimposed on the information signal..." in lines 42-43. There is insufficient antecedent basis for this limitation in the claim since the only reference to superimposing is found at lines 36-38 that recite the limitation "means for superimposing the device-related information from the recording side device-related information obtaining means using said first code." Lines 36-38 do not specify that the device-related information is superimposed on the information signal.

As for claim 80, the claim recites the limitation in lines 20-22: "detecting means for determining whether the device-related information added to the information signal input means;" The claim does not recite any further limitation that explains what characteristic of the device-related information, the detecting means is investigating. Lines 23-26 are equally confused. The functions of the determining means and the detecting means appear to be confused in the claim.

Claims 81-87, which are dependent on claim 80, are thereby rejected on the same basis as is that claim.

Claim 93 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The claim preamble is directed towards a device, i.e., an apparatus, and yet the claim also recites a final limitation directed towards a "control step" or process. See MPEP Sec. 2173.05:

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claims 94-100, which are dependent on claim 93, are rejected on the same basis as is that claim.

As for claim 125, it recites the limitation in line 4 of: "the step of obtaining step." The meaning of the passage is not clear.

As for claim 132, there appears to be a significant amount of text missing from the claim beginning at line 23. As written, the final paragraph recites the limitation in line 24 of "the reproduction of the information signals if..." The meaning of the passage is unclear since no related conditional statement related to this step precedes it.

Claims 133, 134, and 136-140 are dependent on claim 132 and are thereby rejected on the same basis as is that claim.

As for claim 135, there appears to be text missing from the preamble of the claim. The dependency of the claim is missing.

Double Patenting

10. The Examiner has reviewed the paper file, and the appropriate PTO electronic databases (PALM, EDAN, MADRAS) concerning the parent case: US Application 09/131,095, now US Patent 6,282,654, and can find no indication that it was ever made subject to any restriction requirement. The instant application is listed as a divisional application of 09/131,095, however the divisional application did not result from a requirement to restrict the parent application to a single invention. Therefore the provisions of 37 CFR 121 (see MPEP, Sec. 802) prohibiting the application of the parent case as a reference against the instant application are not applicable.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80-87 and 88-92 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-43 of U.S. Patent No. 6,282,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claims 80 and 88 of the instant application adds the feature of an "output device" in addition to the "reproducing device" recited in claim 37 of the Patent. Yet the specification teaches that the "reproducing device" of claim 37 is both an "output device" and a "reproducing device." For example, in the discussion of Figure 6, the Applicant's Specification states: "reproducing device 20 is a device for reproducing and outputting the digital image signals." Based upon this, the terms "reproducing device" and "output device" are synonymous and describe the same feature. Claim 37 of the Patent teaches all of the features of the "reproducing device" and therefore the synonymous "output device" found in claim 80 of the instant invention. Claim 37 of the Patent is a narrower version of claim 80 of the instant application and thereby renders it obvious. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re

Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). Claims 37-43 of the Patent teach all the limitations of claims 81-87 and claims 89-92 of the instant application.

Claims 93-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37-43 of U.S. Patent No. 6,282,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claim 37 of the Patent discloses all of the features of the reproducing device recited in claim 93 of the instant application. The final limitation recited in claim 93 of the instant application is not limiting since it is directed to a method of using the claimed apparatus. Claim 37 of the Patent is a narrower version of claim 93 of the instant application and thereby renders it obvious. “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46

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USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). Claims 37-43 of the Patent teach all of the limitations of claims 94-100 of the instant application.

Claim 101-105 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-43 of U.S. Patent No. 6,282,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claim 37 of the Patent discloses all of the features of the reproducing device recited in claim 101 of the instant application. Claim 37 of the Patent is a narrower version of claim 101 of the instant application and thereby renders it obvious. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the

Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). Claims 37-43 teach all the limitations of claims 102-105 of the instant application.

Claims 106-111, 131 and 112-115 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-32 of U.S. Patent No. 6,282,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claim 27 of the Patent discloses all of the features of the reproducing methods recited in claims 106 and 112 of the instant application. Claim 27 of the Patent is a narrower version of claims 106 and 112 of the instant application and thereby renders them obvious. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). Claims 27-32 of the Patent teach all of the limitations of claims 107-111, 131, and 113-115 of the instant application.

Claims 124-128 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 69-74 of U.S. Patent No. 6,282,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Claim 69 of the Patent discloses all of the features of the reproducing method recited in claim 124 of the instant application. Claim 69 of the Patent is a narrower version of claim 124 of the instant application and thereby renders it obvious. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). Claims 69-74 of the Patent teach all the limitations of dependent claims 125-128 of the instant application.

Allowable Subject Matter

12. Claims 76, 129 and 130 are allowed.
13. The following is an examiner's statement of reasons for allowance:

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of copy control pertinent to the applicant's invention.

Davis 6,611,607

Morito 6,782,190

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

6-16-06

Paul E. Callahan

A handwritten signature in black ink, appearing to read "Paul E. Callahan", written in a cursive style.